

U.S. Patent Application No. 09/929,780
Reply to Office Action dated May 3, 2006

PATENT
450100-03413

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-4, 6-12 and 14-16 are pending in this application. Claims 1 and 9, are independent. Claims 1 and 10 are hereby amended. Claims 5 and 13 have been canceled without prejudice or disclaimer of subject matter. No new matter is added by these amendments. Support for the amended recitations in the claims is found throughout the Specification. Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §112

Claim 10 was rejected under 35 U.S.C. §112. The Office Action states that it 'is vague because it calls for a portable terminal comprising an electronic apparatus and the electronic apparatus comprising the portable terminal....' Claim 10 has been amended, thereby obviating the rejection. Applicants submit that claim 10 is proper and meets the requirements of 35 U.S.C. §112.

U.S. Patent Application No. 09/929,780
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PATENT
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III. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-4, 6, and 8 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Publication No. 2005/0028208 to Ellis, et al. in view of U.S. Patent No. 6,601,074 to Liebenow in view of U.S. Patent No. 6,405,049 to Herrod, et al. and further in view of U.S. Patent No. 5,963,624 to Pope and further in view of U.S. Patent No. 6,594,498 to McKenna, et al.

Claim 7 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Publication No. 2005/0028208 to Ellis, et al. in view of U.S. Patent No. 6,601,074 to Liebenow in view of U.S. Patent No. 6,405,049 to Herrod, et al. and further in view of U.S. Patent No. 5,963,624 to Pope and further in view of U.S. Patent No. 6,594,498 to McKenna, et al. and further in view of U.S. Patent No. 6,501,516 to Clapper.

Claims 9-12 and 14-16 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,870,570 to Bowser in view of U.S. Patent No. 6,601,074 to Liebenow in view of U.S. Patent No. 6,405,049 to Herrod, et al. and further in view of U.S. Patent No. 5,963,624 to Pope and further in view of U.S. Patent No. 6,594,498 to McKenna, et al.

Claim 1 recites, *inter alia*:

"...control means for controlling, under the control of said electronic apparatus, an apparatus having functions of recording and playing broadcast programs in accordance with received selection information;

determination means for determining whether the selection information indicates information that has been recorded by the apparatus having functions of recording and playing broadcast programs and for designating a point for which to begin playback ..." (emphasis added)

U.S. Patent Application No. 09/929,780
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450100-03413

As understood by Applicants, U.S. Publication No. 2005/0028208 to Ellis, et al. (hereinafter, merely "Ellis") relates to an interactive TV guide with remote access.

As understood by Applicants, U.S. Patent No. 6,601,074 to Liebenow (hereinafter, merely "Liebenow") relates to maintaining an electronic program guide that includes episode identifiers associated with program information.

As understood by Applicants, U.S. Patent No. 6,405,049 to Herrod, et al. (hereinafter, merely "Herrod") relates to a portable data device system that include a portable data device and a cradle for receiving the portable data device. The cradle is arranged to recharge the portable data device power supply and upload and download information to and from the portable data device.

As understood by Applicants, U.S. Patent No. 5,963,624 to Pope (hereinafter, merely "Pope") relates to storing a variety of appliance control codes in a cordless telephone handset. The cordless handset can be used as a universal remote for the various appliances.

As understood by Applicants, U.S. Patent No. 6,594,498 to McKenna, et al. (hereinafter, merely "Mckenna") relates to a cellular communication network that operates with existing networks to provide communication services to subscribers.

Applicants submit that nothing has been found in Ellis, Leibenow, Herrod, Pope, or McKenna, taken alone or in combination, that would teach or suggest the above-identified features of claim 1. Specifically, Applicants submit that Ellis, Leibenow, Herrod, Pope, and McKenna fail to teach or suggest control means for controlling, recording and playing broadcast programs in accordance with received selection information and determination means for determining whether the selection information indicates information that has been recorded by

U.S. Patent Application No. 09/929,780
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the apparatus having functions of recording and playing broadcast programs and for designating a point for which to begin playback, as recited in claim 1.

Applicants respectfully submit that the combination of art used as a basis of rejection is improper because it lacks motivation and is based on improper hindsight using the claimed invention as a blueprint.

Therefore, Applicants submits that independent claim 1 is patentable.

With respect to independent claim 9, Applicants respectfully submit that the present application is entitled to the Japanese priority filing date of August 16, 2000. This priority date antedates the October 31, 2000 date to which U.S. Patent No. 6,870,570 to Bowser is entitled. In view of the earlier effective filing date of the present application, Bowser is not available as prior art with respect hereto.

Therefore, Applicants submit that claim 9 is patentable.

Furthermore, Applicants submit that neither Bowser nor Clapper provide the disclosure missing in Ellis, Leibenow, Herrod, Pope, and McKenna.

IV. DEPENDENT CLAIMS

The other claims are dependent from one of the independent claims, discussed above, and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

U.S. Patent Application No. 09/929,780
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450100-03413

CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.


Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By



Thomas F. Presson
Reg. No. 41,442
(212) 588-0800